



07-14-03

97.1636

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Tong, et al.

APPLICATION NO: 09/938,391

Examiner: Kaushal, Sumesh

FILING DATE: August 24, 2001

Group Art Unit: 1636

TITLE: METHODS AND COMPOSITIONS FOR DIAGNOSING AND  
TREATING DISORDERS INVOLVING ANGIOGENESIS

MAIL STOP NON-FEE AMENDMENTS  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
WASHINGTON, D.C. 20231



#15

Sir:

**RESPONSE**

This Response is being submitted in response to an Office Action dated  
June 10, 2003, paper no. 14.

Restriction to one of the following groups was required under 35 U.S.C. §

121:

- I. Claims 1-11, drawn to an isolated nucleotide sequence, expression vector, and host cells encoding endostatin, classified 435, subclass 69.1.
- II. Claims 12-13, drawn to a transgenic non-human animal encoding endostatin classified in class 800, subclass 8.
- III. Claims 14 and 16-20, drawn to an isolated endostatin polypeptide, classified in class 530, subclass 350.
- IV. Claim 15, drawn to an antibody that binds to endostatin, classified in class 350, subclass 387.1.
- V. Claims 21-26, drawn to a method of treating an angiogenesis-related disorder in a subject by administering a small organic molecule that modulates endostatin expression and/or activity, classified in class 514, subclass 2.
- VI. Claims 21-26, drawn to a method of treating an angiogenesis-related disorder in a subject by administering an antibody that modulates endostatin expression and/or activity, classified in class 424, subclass 130.1.
- VII. Claims 21-26, drawn to a method of treating an angiogenesis-related disorder in a subject by administering a ribozyme or an antisense

molecule that modulates endostatin expression and/or activity, classified in class 514, subclass 44.

VIII. Claims 27-35, drawn to a method of identifying compounds that modulates expression and/or activity of an endostatin sequence, classified in class 435, subclass 375.

Applicants provisionally elect Group I, claims 1-11, for prosecution purposes, with traverse. Applicants hereby conditionally withdraw claims 12-36 from prosecution, without prejudice, and request reconsideration of the restriction requirement.

Applicants traverse the restriction requirement based on the following grounds. It is respectfully submitted that the restriction requirement practice was established to promote efficiency of prosecution in the United States Patent Office. All groups of the claims relate to polynucleotide sequences associated with the regulation of angiogenesis and uses thereof. It is a well established and accepted practice in the United States Patent Office to claim peptides, related nucleotide sequences, expression vectors, host cells, antibodies, and various associated methods for using the isolated nucleotide sequences, expression vectors, peptides, and/or host cells in the same application and without restriction. Accordingly, Applicants believe that it is entirely reasonable, and would not present an undue burden on the Patent Office, for the claims of all of the groups to be kept together in the instant application. It is respectfully submitted that examination of all of these groups of claims in a single application would be efficient, thereby promoting the grounds for the establishment of the restriction requirement practice. Hence, it is respectfully requested that the restriction should not be required and that Applicants have traversed the restriction requirement. As stated above, however, Applicants have provisionally elected the claims of Group I and provisionally withdraw claims 12-36, without prejudice, pending reconsideration of the restriction requirement.

The Office Action also states that Applicants are further required under 35 U.S.C § 121 to elect a single disclosed species to which the claims would be restricted if no generic claims is finally held to be allowable. Further, Applicants are required to list all claims readable thereon including those subsequently added. Since claims 1-11 of Group I have been elected by Applicants, Applicants elect the species of cancer. Applicants elect the above species without traverse.

The application is now in condition for allowance, which allowance is respectfully solicited.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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Dated: July 10, 2003

**CERTIFICATE OF MAILING**

Express Mail Mailing Label No.: EV 338 883 003 US  
Date of Deposit: July 10, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Non-Fee Amendments, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Marie M. DeWitt